

5741-01-EJF
Application No. 09/284,858

REMARKS

I. Status of the Application

This paper responds to a Final Office Action, which was mailed on October 22, 2003. The original application was filed with claims 1-7. In response to an Office Action mailed April 17, 2000, which rejected all of the claims, Applicant amended claims 1 and 3 and added claims 8-20. A subsequent Final Office Action, which was mailed on February 9, 2001, maintained the rejection of claims 1-7, rejected newly added claims 8-10, and withdrew from consideration claims 11-20 as being drawn to a non-elected invention. Following the February 9, 2001 Final Office Action, Applicant filed an After Final Amendment, which was not entered. On May 7, 2001, Applicant filed a Continued Prosecution Application, together with a Preliminary Amendment that amended claim 1 and canceled claims 8 and 9. An Office Action mailed on August 15, 2001, again rejected claims 1-7 and 10. Applicant filed a response on December 17, 2001, presenting arguments regarding patentability. A Final Office Action was mailed on April 16, 2002, which maintained the rejection of claims 1-7 and 10. In response, Applicant submitted an After Final Amendment on June 13, 2002, which was refused entry in a subsequent Advisory Action. Applicant filed a Request for Continued Examination (RCE) on July 16, 2002. As part of the RCE, Applicant submitted an After Final Amendment, which amended claim 1. On December 11, 2002, Applicant responded to a Species Election Requirement that was mailed on November 12, 2002. On July 16, 2003, Applicant filed an amendment in response to an Office Action mailed on March 17, 2003, which rejected claims 1-5 and 10, and withdrew claims 6 and 7 from consideration. The present paper amends claim 1, cancels claims 3, 4, 6, 7, and 11-20 without prejudice or disclaimer, and adds new claims 21-23. Accordingly, claims 1, 2, 5, 10, and 21-23 are currently under consideration.

Applicant submits that entry of this after final amendment is proper because it raises no new issues requiring a further search of the prior art and it places the claims in condition for allowance. Applicant respectfully requests reconsideration of the pending

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claims in view of the above amendment and the following remarks. By action taken here, Applicant in no way intends to surrender any range of equivalents beyond that needed to patentably distinguish the claimed invention as a whole over the prior art. Applicant expressly reserves all such equivalents that may fall in the range between Applicant's literal claim recitations and combinations taught or suggested by the prior art.

II. Amendment of Claim 1

Claim 1 has been amended to clarify that the matrix consists of one polymer and that the solid dispersion is made by mixing the pharmaceutical agent and the polymer at a temperature sufficiently high to melt or soften the polymer, but insufficiently high to melt the pharmaceutical agent. As noted in a prior response, this ensures that the pharmaceutical agent retains the form of crystalline particles after being dispersed in the polymer matrix. The specification, as filed, fully supports the changes to claim 1, and therefore the amendment introduces no new matter.

III. New Claims 21-23

New claim 21 is original claim 2 written in independent form. New claims 22 and 23 depend on claim 21, and include most of the limitations of original claim 5 and of previously added claim 10, respectively.

IV. Rejection of Claims 1, 5 and 10 Under 35 U.S.C. §§ 102(e)

The Final Office Action rejected claims 1, 5, and 10 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 5, 641,516 to Grabowski et al. Applicant respectfully traverses the rejection. As noted above, Applicant has amended claim 1 so that the matrix includes one polymer. Therefore, the Grabowski '516 patent does not anticipate claim 1 or claims 5 and 10, which depend on claim 1. Furthermore, for the reasons provided in Applicant's response filed on July 16, 2003, Applicant submits that, when viewed alone or in combination, the Grabowski '516 patent and the other references cited in the case do not render claims 1, 5, and 10 obvious.

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V. Allowable Subject Matter, Claims 2-4

The Final Office Action objected to claims 2-4 as being dependent upon a rejected base claim, but otherwise allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. As noted above, Applicant has rewritten original claim 2 in independent form as new claim 21. Applicant has also added new claims 22 and 23, which depend on claim 21, and which include most of the limitations of claims 5 and 10, respectively. Applicant respectfully submits that claims 21-23 are therefore in condition for allowance since claim 21 includes all of the limitations of prior claims 1 and 2, and since claims 22 and 23 depend on claim 21.

VI. Conclusion

In view of the foregoing, Applicant respectfully submits that all pending claims are patentable over the prior art of record. If the Examiner has any questions, Applicant requests that the Examiner telephone the undersigned.

Applicant believes that no fees are required to file the present amendment. However, if any fees are required in connection with the filing of this paper, please charge deposit account number 23-0455.

Respectfully submitted,

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